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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,614	04/05/2001	Ronald A. Katz	258/180 (6646-101NR)	6985

7590 10/17/2002

Attention: Reena Kuyper
A2D, L.P.
9220 Sunset Blvd., Suite 315
Los Angeles, CA 90069

EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/827,614

Applicant(s)
Katz

Examiner
Stella Woo

Art Unit
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-52 is/are pending in the application
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. This Office action is in response to the Preliminary Amendment filed April 11, 2002.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 29 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 5,255,309. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 29 and 41 in the continuation are broader than claim 24 of the U.S. patent, In re Van Ornum and Stang, 214 USPQ 761. For example, claim 29 of the present invention is the same as claim 24 of the patent except it does not recite a voice generator structure. Therefore, claim 29 of the present invention is broader than previously patented claim 24.

4. Claims 29-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-18, 20-22, 25, 77-80, 94 of U.S. Patent No. 5,561,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in minor changes in wording.

5. Claims 29-34, 39-46, 51-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 12 of U.S. Patent No. 6,035,021. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 29-34, 39-46, 51-52 are broader than claims 1-6, 12 of the patent, In re Van Ornum and Stang, 214 USPQ 761. For example, claim 29 of the present invention is the same as claim 3 of the patent except it does not recite the tests being conducted before processing of the caller data signals. Therefore, claim 29 of the present invention is broader than previously patented claim 3.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-34, 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 4,763,191, hereinafter "Gordon") in view of Troy et al. (US 4,494,197, hereinafter "Troy").

Gordon discloses a system comprising:

interface structure (local exchange carrier network 109 provides ANI signals and forwards caller data signals provided from the calling touch-tone telephone 111; col. 5, line 67 - col. 6, line 5; col. 6, lines 38-51; col. 7, lines 2-48; col. 8, line 59 - col. 9, line 7; col. 9, lines 47-60);

record testing structure (the calling line number is compared with stored data in database 206 to verify entitlement; col. 8, lines 3-23);

analysis structure (processor 205; col. 8, lines 21-38).

Gordon differs from the claims in that it does not specify receiving a caller's social security number. However, as taught by Troy (col. 4, lines 54-60), it is well known to use a social security number for verifying a user's identity such that it would have been obvious to an artisan

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of ordinary skill to incorporate the use of a social security number, as taught by Troy, within the system of Gordon for further identifying the caller.

Regarding claims 30-34, 42-46, in Gordon, the caller provides credit card information which is verified on a dial-up basis (col. 3, lines 1-3; col. 10, lines 35-38).

8. Claims 39 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon and Troy, as applied to claims 29-34, 41-46 above, and further in view of Stephenson, Jr. et al. (US 3,727,186, hereinafter "Stephenson").

The combination of Gordon and Troy differs from claims 39 and 51 in that although it does teach determining whether or not a credit card number is authorized, it does not specify the credit verification process as including testing for negative file data. However, Stephenson teaches that it is old and well known in the credit authorization art to test for negative file data (warning file 30) when determining whether or not a credit card number is authorized (col. 5, lines 22-28; col. 6, lines 30-37) such that it would have been obvious to an artisan of ordinary skill at the time of invention to test for negative file data, as taught by Stephenson, within the combination of Gordon and Troy in order to quickly identify an invalid credit card number.

9. Claims 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon and Troy as applied to claims 29-34, 41-46 above, and further in view of the publication entitled "The AT&T Multi-Mode Voice Systems - Full Spectrum Solutions for Speech Processing Applications" (hereinafter "Hester").

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The combination of Gordon and Troy differs from claims 40 and 52 in that it does not recite the use of DNIS for selecting a specific operating format. However, Hester teaches the well known of DNIS for selecting a specific operating format from a plurality of formats and interacting with the caller according to the specified format (see entire publication) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of DNIS, as taught by Hester, within the combination of Gordon and Troy in order to more quickly determine the service desired by a caller.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

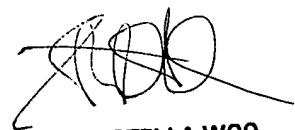
or faxed to:

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

October 9, 2002


STELLA WOO
PRIMARY EXAMINER